

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 5, 2002. Claims 1-83 were pending in the Application.

Applicant affirms the election of Claims 1-62, as discussed previously with the Examiner on October 9, 2002. In light of this election, Applicant cancels Claims 63-83, without prejudice or disclaimer.

As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Consideration of Information Disclosure Statements

Applicant submitted an Information Disclosure Statement dated October 2, 2002. However, the Examiner has not indicated that he considered the references in this Information Disclosure Statement. In addition, Applicant submitted an Information Disclosure Statement dated May 17, 2001, in which two cited references were not shown as considered by the Examiner. Pursuant to M.P.E.P. § 609, Applicant respectfully requests the Examiner to consider the art cited in these Information Disclosure Statements, and in the event a patent issues on this Application, that this art be printed on the face of the issued patent. A copy of the Information Disclosure Statements listed above and a copy of each PTO-1449 attached thereto is enclosed with this response for the Examiner's consideration. Applicant respectfully requests a copy of each PTO Form-1449 for these Information Disclosure Statements indicating the Examiner's consideration of the references.

Section 103 Rejections

Claims 1-3, 10-15, 32-34, and 41-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Busuioc* (U.S. Patent No. 6,151,309) in view of *Van den Heuvel* (U.S. Patent No. 5,301,359). In addition, Claims 4, 6, 35, and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Busuioc* in view of *Van den Heuvel* and further in view of *Smyth* (U.S. Patent No. 6,347,224). Furthermore, Claims 7-9, 16-31, 38-40, and 47-62 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Busuioc* in view of *Van den Heuvel* and further in view of *Smyth* and *Budhraj*a (U.S. Patent No. 6,324,185).

The Cited Art Fails to Suggest or Motivate a Combination of References

In order to establish a prima facie case of obviousness through a combination or modification of references, there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references. See M.P.E.P. § 2143. Applicant respectfully argues that none of the prior art references cited by the Examiner disclose such a suggestion or motivation. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." M.P.E.P. § 2143.01. *Busuioc*, *Van den Heuvel*, *Smyth*, and *Budhraj*a all fail to teach such a desirability.

In addition, the combination of prior art references without any evidence of a suggestion, teaching, or motivation to combine results in taking the present invention as a blueprint for piecing together prior art to defeat patentability. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1998). This is impermissible hindsight as the invention cannot be viewed with the blueprint drawn by the inventor. See *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1138 (Fed. Cir. 1985). In regard to certain claims of the present Office Action, the Examiner is merely using the present invention as a blueprint to piece together elements of various references when these references all fail to suggest or motivate any combination between them.

In rejecting the present claims as obvious over the prior art, the Examiner should present evidence that suggests or motivates the modification, as is required by Federal Circuit case law. See e.g., *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed. Cir. 1985). Evidence of teaching

or suggestion of the combination of prior art references to achieve the claimed invention is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

In the present Office Action, the Examiner has merely stated that it would have been obvious to one skilled in the art at the time this invention was made to modify or combine the cited references. However, the Examiner cites no language in the cited references that would suggest or motivate the combination of references. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence" of a suggestion or motivation to combine references. *Dembiczak*, 175 F.3d at 999.

Rejections Over *Busuioc* In View of *Van den Heuvel*

In addition to the fact that the cited references fail to suggest or motivate a combination, Claims 1, 5, 12, 32, 36, and 43, and all claims that depend from those claims, are patentable over *Busuioc* in view of *Van den Heuvel* for at least the reason that *Busuioc* and *Van den Heuvel*, alone or in combination, fail to teach all of the claimed elements of the present invention, as required by M.P.E.P § 2143.

For example, Claim 1 recites a geo-location tool operable to receive data for a wireless communications network and operable to "estimate bandwidth parameters for a geo-location area based on the data." Furthermore, Claim 32 recites "estimating bandwidth parameters for a geo-location area based on the data." The Examiner notes that *Busuioc* is silent as to the ability to estimate bandwidth parameters. (11/05/02 Office Action, Issue 3, ¶2). The Examiner also states that *Van den Heuvel* discloses estimating bandwidth parameters for a geo-location area based on data. (11/05/02 Office Action, Issue 3, ¶2). Applicant respectfully disagrees. *Van den Heuvel* does not disclose estimating bandwidth parameters based on data. *Van den Heuvel* merely discloses receiving data regarding the availability of various communication systems. (*Van den Heuvel*; Col. 2, lines 52-61). Nowhere in *Van den Heuvel* is there any disclosure of using data received from a wireless communications network to estimate the bandwidth parameters for a geo-location area based on that data. In fact, *Van den Heuvel* makes no mention of the ability to estimate bandwidth parameters in any manner. Consequently, independent Claims 1 and 32 are patentable over *Busuioc* in view of *Van den Heuvel*. Therefore, Applicants respectfully request reconsideration and allowance of independent Claims 1 and 32 and all claims that depend from those claims.

Furthermore, Claim 5 recites a geo-location tool operable to "estimate bandwidth parameters for a geo-location area on a per service class basis." Claim 36 recites "estimating bandwidth parameters for a geo-location area on a per service class basis." As discussed above with respect to Claims 1 and 32, neither *Van den Heuvel* nor *Busuioc* disclose a system or a method for estimating bandwidth parameters, and certainly not on a per service class basis. Consequently, Claims 5 and 36 are patentable over *Busuioc* in view of *Van den Heuvel*. Therefore, Applicants respectfully request reconsideration and allowance of Claims 5 and 36 and all claims that may depend from those claims.

In addition, Claim 12 recites a geo-location tool operable to generate a "subscriber usage profile indicating the probability of a subscriber engaging in a connection at the geo-location area and estimate bandwidth parameters based on the subscriber usage profile." Claim 43 recites generating a "subscriber usage profile indicating the probability of a subscriber engaging in a connection at the geo-location area" and "estimating bandwidth parameters based on the subscriber usage profile." As discussed above with respect to Claims 1 and 32, neither *Van den Heuvel* nor *Busuioc* disclose a system or a method for estimating bandwidth parameters. Furthermore, Applicant respectfully disagrees that *Busuioc* discloses generating a subscriber usage profile indicating the probability of a subscriber engaging in a connection in the geo-location area. Nowhere in the excerpts cited by the Examiner (*Busuioc*; Col. 5, lines 12-67; Col. 6; lines 1-44), or in any other part of *Busuioc*, is there a disclosure of a subscriber usage profile that indicates the probability of a subscriber engaging in a connection in a certain geo-location area. Consequently, Claims 12 and 43 are patentable over *Busuioc* in view of *Van den Heuvel*. Therefore, Applicants respectfully request reconsideration and allowance of Claims 12 and 43 and all claims that may depend from those claims.

Rejections Over *Busuioc* In View of *Van den Heuvel* and *Smyth*

Claims 4 and 35 recite bandwidth parameters that comprise bandwidth interference contribution for the geo-location area. The Examiner states that neither *Busuioc* nor *Van den Heuvel* disclose these limitations. (11/05/02 Office Action, Issue 4, ¶ 2). However, the Examiner also states that *Smyth* discloses this limitation and that it would have been obvious to one skilled in the art at the time the invention was made to modify *Smyth* to include the

teachings of *Van den Heuvel* and *Busuioc*. As stated above, *Smyth*, *Van den Heuvel*, and *Busuioc* all fail to suggest or motivate any such combination. In this instance, the Examiner has merely combined multiple references based on the blue print provided by the present application. This amounts to impermissible hindsight under Federal Circuit case law.

In addition, the Examiner states that *Smyth* discloses bandwidth parameters that comprise bandwidth interference contribution for the geo-location area. (11/05/02 Office Action, Issue 4, ¶ 2). Applicant respectfully disagrees. While *Smyth* may mention that multiple channel connections can cause congestion in the network (*Smyth*; Col. 10, Lines 45-67), there is no disclosure that the bandwidth parameters comprise bandwidth interference contribution for the geo-location area. *Smyth* simply notes that congestion may occur and that a user may be charged for each channel used in a communication, but makes no mention that bandwidth is allocated in the geo-location area based on bandwidth interference contribution, as is recited by Claims 4 and 35.

For at least these reasons, the Examiner has failed to establish a prima facie case of obviousness per M.P.E.P. § 2143. Consequently, Claims 4 and 35 are patentable over *Busuioc* in view of *Van den Heuvel* and further in view of *Smyth*. Therefore, Applicants respectfully request reconsideration and allowance of Claims 4 and 35 and all claims that depend from those claims.

Rejections Over *Busuioc* In View of *Van den Heuvel*, *Smyth*, and *Budhraj*

Claim 7 recites a geo-location tool operable to generate a source map comprising sources of bit usage and to estimate bandwidth parameters based on the source map. Similarly, Claim 38 recites generating a source map comprising sources of bit usage and to estimate bandwidth parameters based on the source map. The Examiner states that neither *Busuioc* nor *Van den Heuvel* disclose these limitations. (11/05/02 Office Action, Issue 5, ¶ 2). However, the Examiner also states that *Smyth* and *Budhraj*, in combination, disclose these limitations and that it would have been obvious to one skilled in the art at the time the invention was made to modify *Smyth* and *Budhraj* to include the teachings of *Van den Heuvel* and *Busuioc*. As stated above, *Smyth*, *Budhraj*, *Van den Heuvel*, and *Busuioc* all fail to suggest or motivate any such combination. In this instance the Examiner has merely combined multiple references based on the blue print provided by the present application. This amounts to impermissible hindsight under Federal Circuit case law.

Furthermore, as discussed above with respect to Claims 1 and 32, neither *Van den Heuvel* nor *Busuioc* disclose a system or a method for estimating bandwidth parameters. In addition, *Smyth* and *Budhraj*a fail to teach a system or method for estimating bandwidth parameters. Therefore, *Busuioc*, *Van den Heuvel*, *Smyth*, and *Budhraj*a all fail to teach an element recited in Claims 7 and 38.

For at least these reasons, the Examiner has failed to establish a prima facie case of obviousness per M.P.E.P. § 2143. Consequently, Claims 7 and 38 are patentable over *Busuioc* in view of *Van den Heuvel* and further in view of *Smyth* and *Budhraj*a. Therefore, Applicants respectfully request reconsideration and allowance of Claims 7 and 38 and all claims that depend from those claims.

Furthermore, regarding Claims 16, 20, 24, 28, 47, 51, 55, and 59, the Examiner states that neither *Busuioc* nor *Van den Heuvel* disclose the limitations recited by these claims (11/05/02 Office Action, Issue 5, ¶5, ¶9, ¶13, ¶17). However, the Examiner also states that *Smyth* and *Budhraj*a, in combination, disclose the limitations of these claims and that it would have been obvious to one skilled in the art at the time the invention was made to modify *Smyth* and *Budhraj*a to include the teachings of *Van den Heuvel* and *Busuioc*. Applicant respectfully disagrees with respect to all cited claims. As stated above, *Smyth*, *Budhraj*a, *Van den Heuvel*, and *Busuioc* all fail to suggest or motivate any such combination of references. With respect to each of these claims, the Examiner has merely combined multiple references based on the blue print provided by the present application. This amounts to impermissible hindsight under Federal Circuit case law. For at least this reason, the Examiner has failed to establish a prima facie case of obviousness per M.P.E.P. § 2143. Consequently, Claims 16, 20, 24, 28, 47, 51, 55, and 59 are patentable over *Busuioc* in view of *Van den Heuvel* and further in view of *Smyth* and *Budhraj*a. Therefore, Applicants respectfully request reconsideration and allowance of Claims 16, 20, 24, 28, 47, 51, 55, and 59 and all claims that depend from these claims.

CONCLUSION


Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicant, at the Examiner's at (214) 953-6986.

Although no other fees are believed due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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